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| APPLICATION NO.                        | FILING DATE   | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.     | CONFIRMATION NO. |  |
|--|---------------|----------------------|-------------------------|------------------|--|
| 09/975,396                             | 10/10/2001    | Kousei Sano          | 10873.822US01           | 1183             |  |
| 7590 05/25/2004                        |               | EXAMINER             |                         |                  |  |
| Merchant & Gould P.C.<br>P.O. Box 2903 |               |                      | HUBER, PAUL W           |                  |  |
|  | IN 55402-0903 |                      | ART UNIT                | PAPER NUMBER     |  |
|  |               |                      | 2653                    | 4                |  |
|  |               |                      | DATE MAILED: 05/25/2004 |                  |  |

Please find below and/or attached an Office communication concerning this application or proceeding.

|  |   |   | _ |
|--|---|---|---|
|  | Application No.   | Applicant(s)  |   |
| . Office Action Comments   | 09/975,396  | SANO ET AL.   |   |
| Office Action Summary  | Examiner  | Art Unit  |   |
|  | Paul Huber  | 2653  | _ |
| The MAILING DATE of this communication apprehension for Reply  | ears on the cover sheet wil   | h the correspondence address  |   |
| A SHORTENED STATUTORY PERIOD FOR REPLY THE MAILING DATE OF THIS COMMUNICATION.  - Extensions of time may be available under the provisions of 37 CFR 1.13 after SIX (6) MONTHS from the mailing date of this communication.  - If the period for reply specified above is less than thirty (30) days, a reply If NO period for reply is specified above, the maximum statutory period w  - Failure to reply within the set or extended period for reply will, by statute, Any reply received by the Office later than three months after the mailing earned patent term adjustment. See 37 CFR 1.704(b).   | 6(a). In no event, however, may a rewithin the statutory minimum of thirty ill apply and will expire SIX (6) MON cause the application to become AB | ply be timely filed  r (30) days will be considered timely.  FHS from the mailing date of this communication.  ANDONED (35 U.S.C. § 133). |   |
| Status   |   |   |   |
| 1)  Responsive to communication(s) filed on  2a)  This action is <b>FINAL</b> . 2b)  This  3)  Since this application is in condition for allowan closed in accordance with the practice under E   | action is non-final.<br>ce except for formal matte  | • •   |   |
| Disposition of Claims  |   |   |   |
| 4) ⊠ Claim(s) 1-17 is/are pending in the application. 4a) Of the above claim(s) is/are withdraw 5) □ Claim(s) is/are allowed. 6) □ Claim(s) is/are rejected. 7) □ Claim(s) is/are objected to. 8) ⊠ Claim(s) 1-17 are subject to restriction and/or expressions.   |   |   |   |
| Application Papers   |   |   |   |
| 9) The specification is objected to by the Examiner 10) The drawing(s) filed on is/are: a) access applicant may not request that any objection to the of Replacement drawing sheet(s) including the correction of the original transfer and the correction of the correction o | epted or b) objected to be drawing(s) be held in abeyan on is required if the drawing(  | ce. See 37 CFR 1.85(a).<br>s) is objected to. See 37 CFR 1.121(d).  |   |
| Priority under 35 U.S.C. § 119   |   |   |   |
| 12) Acknowledgment is made of a claim for foreign a) All b) Some * c) None of:  1. Certified copies of the priority documents 2. Certified copies of the priority documents 3. Copies of the certified copies of the prior application from the International Bureau * See the attached detailed Office action for a list of   | s have been received. s have been received in A ity documents have been (PCT Rule 17.2(a)).   | oplication No received in this National Stage   |   |
| Attachment(s)  1) Notice of References Cited (PTO-892)  2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date  | Paper No(s  | ummary (PTO-413)<br>)/Mail Date<br>formal Patent Application (PTO-152)<br>·   |   |

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## **DETAILED ACTION**

## Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- Claims 1-16, drawn to an optical head apparatus, an information recording and reproducing apparatus, and a method for detecting aberration, classified in class 369, subclass 53.12.
- II. Claim 17, drawn to a method for adjusting an optical head apparatus, classified in class 369, subclass 112.01.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination.

The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as being utilized in a device which does not require a rotation mechanism for rotating a light dividing means as required by the invention II. Invention II also has separate utility such as being utilized in a device which does not require detecting aberration of light converged on the information storage medium by using signal from a second photo detector as required by the invention I. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

This application contains claims directed to at least the following eight patentably distinct species of the claimed invention: figures 1 & 2; figures 1 & 6; figure 10; figure 13; figure 16; figure 19; figure 22; and figure 26, corresponding to Species 1-8, respectively.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim is considered generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as

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provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

A telephone call was not made to the applicants' representative to request an oral election to the above restriction requirement due to the nature of the application, e.g., foreign applicants, and the need for the examiner to promptly act on the application.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Huber whose telephone number is 703-308-1549. The examiner can normally be reached on Flexi-Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Korzuch can be reached on 703-305-6137. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-2/17-9197 (toll-free).

> Paul Huber Primary Examiner Art Unit 2653

May 21, 2004